REMARKS

A restriction requirement has been made in this case, resulting in the withdrawal from consideration of claims 1-10. Claims 11-17 remain pending. Claims 18-23 are newly added.

Applicants respectfully traverse the restriction requirement – it is not clear that the Office has met its *prima facie* burden of showing that the two sets of claims are both independent and distinct. Moreover, even if the claims are independent and distinct, it is not believed that maintaining the two groups of claims in the application would be unduly burdensome on the Office. Accordingly, withdrawal of the restriction requirement is solicited.

Applicants respectfully disagree with the rejections under §§ 112 and 101.

The claims are sufficiently definite to define the metes and bounds of the claimed invention. For example, what is included in the scope of claim 10 is, e.g., an (1) invoice that (2) has machine readable indicia, where the indicia (3) represents plural bits of binary data, and (4) is generally unintelligible to human observers of the indicia. Requirements (1) – (4) demark bounds of the claim.

It will be recognized that the claim is not an omnibus claim. As described in §MPEP 2175.05(r), such a claim is of the form "A device substantially as shown and described." As pointed out above, claim 10 is not of that sort. Nor are the other claims.

Contrary to the Action, claim 10 does not provide for the use of a machine. Nor do the other claims. Describing a claim element with reference to a function it serves does not require use of a machine to infringe.

The rejection under §101 is also traversed. The cited law concerns a claim drawn to a method. Claim 10 is not drawn to a method, but rather to "An invoice having…"

As to the assertion of non-statutory subject matter, it should be recognized that the general rule is "Anything under the Sun that is made by Man" constitutes patentable subject matter.[1] Applicants acknowledge that ideas in the abstract, such as abstract ideas or laws of nature, and natural phenomena, are not patentable. But it will be recognized that the claimed invoice is not such an "idea in the abstract."

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[1] *Diamond v. Chakrabarty* (U.S., 1980).

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The Examiner is mistaken in stating that the inventive concept in claims 10-17 is directed to a machine readable indicia. Such an interpretation takes three words in one claim and ascribes to them to claim's sole meaning – disregarding all of the other claim language. Such an interpretation is not fair.

If the Office has any doubts about the patentability of claims directed to printed documents with functional markings, reference may be made to issued patents, such as 5,062,666 and 6,209,923 and 6,167,147 and 6,050,607 and 5,853,197 and 5,259,649, which include claims of this sort:

> *1. An international financial instrument comprising a face having a first area and a second area, a multi-letter international monetary code printed on said first area, an amount printed on said second area, said monetary code comprising a three letter code consisting of letters printed in a negative pattern and formed by a series of rows of printed dots to define an outline of each of said letters.*

and

> *2. A security document comprising:*
> *a security image printed on a face of said document, wherein said security image includes a collection of security image elements defining a document authentication scheme arranged to provide an indication of document authenticity; and*
> *a covert trigger printed on said face of said document, wherein said covert trigger is defined by a collection of trigger elements, and wherein said trigger elements are arranged to resemble selected ones of said security image elements such that said covert trigger is not readily apparent on said face of said document, and wherein said covert trigger is arranged to provide an indication of document authenticity in addition to and independent of the indication of document authenticity provided by said document authentication scheme of said security image.*

and

> *26. A security document comprising:*
> *a security image area on the face of said document, wherein said security image area is divided into a plurality of image element cells, such that said image element cells define an array of image element cells across said security image area, and wherein each of said image element cells is divided into a plurality of*

pixels, such that each image element cell defines a cell pixel array;

a printed security image within said security image area, wherein said printed security image comprises printed pixel clusters within respective ones of a set of active image element cells such that at least a portion of each printed pixel cluster is positioned within respective active image element cells, wherein each of said printed pixel clusters defines a predetermined image element, wherein said set of active image element cells defines said security image, and wherein said printed pixel clusters are positioned within each of said active image element cells on a substantially random basis; and

a printed complementary security image within said security image area, wherein said printed complementary security image comprises a set of predetermined complementary image elements.

and

1. A security document comprising a security image area defined on a face of said document, wherein:

said security image area is divided into a plurality of image element cells defining an array of image element cells across said security image area;

respective printed tiling elements are printed in selected ones of said image element cells to define a printed security image and a printed complementary security image within said security image area;

individual ones of said printed tiling elements comprise printed units positioned within said respective image element cells;

said printed units are positioned such that image element cells including said respective printed tiling elements define substantially identical repeating printed elements, and such that individual ones of said repeating printed elements comprise apportioned repeating printed elements; and

said apportioned repeating printed elements are defined by a combination of printed units from neighboring image element cells.

and

1. A security document comprising:

a substrate having a top surface for carrying printed indicia;

said top surface defining a plurality of areas; said areas being organized in an ordered array; each of said areas containing:

a) background printed matter printed on said top surface, said background printed matter made up of a pattern of background elements; and

b) a security term printed on said top surface of said substrate, said security term composed of a pattern of security term elements; wherein, said background elements, or said security term elements, or both, within one of said areas, differ in element shape from background elements and security term

elements within another of said areas; and further, wherein, within each of said areas, either said background elements or said security term elements are not readily duplicated by a color copier while the remaining elements in said area are readily duplicated by a color copier, whereby, upon copying of said security document, a visually perceptible security term is produced.

and

1. A credit-card comprising as identification of an authorized card-holder a sequence selected from numbers and letters, wherein in addition to an authorizing sequence the card bears a plurality of indicia imprinted on a substrate selected from a sequence of numbers and letter, one of which is an authorizing code to be used by a user for purchases, said groups further comprising different geometrical shapes one of said geometrical shapes identifying the authorizing code, which pattern cannot be identified by an unauthorized user.

It is not clear that the Office considered claim 17.

Turning to the prior art rejection, each of the claims is said to be anticipated by the teachings of Antognini (20020023055). Applicants respectfully traverse the rejections.

The cited art is not understood to teach each of the claims' limitations. For example, the art is not understood to teach an invoice (or check) having a generally un-intelligible (to humans) machine readable indicia representing plural bits of binary data, where the binary data serves to indicate an on-line computer address associated with the invoice (or check). Nor is the art understood to teach that the indicia includes an identifier that is associated with the on-line computer address through a database record.

Instead, the art seems to generally relate to digital bill presentment/payment, in which some embodiments include taking textual information printed on the bill, and also encoding that information in a machine readable code (and related variants).

If the rejection is renewed, the Examiner is requested to provide more specific citations to the art's alleged teachings, e.g., where does Antognini teach that the encoded binary data on a printed invoice indicates an on-line computer address with an invoice?

Nothing in the cited art appears to be related to a steganographic digital watermark. Again, if the rejection is renewed, a specific cite to the alleged teaching of Antognini is requested.

New claims 18-23 are submitted to more fully protect applicants' inventive work. The claim limitations are modeled after those earlier presented in connection with claims 11-14.

The Examiner is requested to withdraw the rejections and pass the case to allowance, so that the Board will be spared this task.

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Respectfully submitted,

CUSTOMER NUMBER 23735

DIGIMARC CORPORATION

By_____
William Y. Conwell
Registration No. 31,943

Phone: 503-885-9699
FAX 503-885-9880